

**REMARKS**

Claims 31-40 are pending in the application and are rejected.

***Claims 31-34***

The Office Action indicates claims 31-34 are rejected under 35 U.S.C. § 101 for being directed toward non-statutory subject matter but would be allowable if rewritten to recite the claimed method steps are performed by a computer or machine.

In response, Applicants amend the independent claim 31 as shown above and request reconsideration.

***Claims 35-36***

The Office Action indicates claim 35 is rejected under 35 U.S.C. § 102 for being anticipated by U.S. patent 6,029,182 (referred to as "Nehab") and claim 36 is rejected under 35 U.S.C. § 103 as being unpatentable over Nehab in view of U.S. patent 5,649,186 (referred to as "Ferguson").

Applicants respectfully traverse the rejection of these claims because Nehab does not disclose all features of claim 35; claim 36 is dependent on claim 35 and adds further limitations.

Nehab discloses a system for generating a custom formatted newspaper by retrieving articles and formatting the articles' content according to a personal-news-profile. The basic operation of the disclosed system "traverses a hypermedia document on the Web, extracts data according to user-defined information, and formats the data into a personalized newspaper" (col. 7 lns. 13-16).

The method set forth in claim 35 provides two types of information to a recipient that pertain to a newspaper. One type of information is the content of the newspaper itself. The other type information is a summary of this content. The claimed method comprises (this is an abbreviation of actual claim language to which letters have been added for convenient reference):

- (a) obtaining recipient preferences;
- (b) identifying documents having content according to recipient preferences;
- (c) obtaining content of the documents and a summary of the content;
- (d) generating a first representation of the content for a printer device;
- (e) generating a second representation of the summary for a display device; and
- (f) delivering the first second representations.

The Office Action relies on the text appearing in cols. 8-10 of Nehab to support the rejection of claim 35; however, substantially all of this text pertains only to step (a) that describes a process for defining a personal news profile. The only portion of the cited text that pertains to the retrieval and

presentation of articles (the rest of claim 35) appears in col. 10 lns. 26-35. This text (and all other text in Nehab) does not disclose or suggest all features of steps (c) to (f) in claim 35.

Nehab does not disclose or suggest step (c) that obtains content information representing content of identified documents and summary information summarizing content represented by the content information. The Office Action does not mention "summary information" but may be intending to refer to this type of information by referring to "generating a list" near the middle of page 5. If this is what is intended, it is not clear what "list" is being referred to. Applicants can only respond in general by pointing out the portion of the text that is cited refers only to the process used to define a user profile. Such a list does not pertain to the content of documents that are retrieved according to this profile.

Nehab does not disclose or suggest step (d) that generates a first representation of content information that is not intended for presentation by a printer but not intended for presentation by a display device. Nehab indicates its system delivers a formatted newspaper that can be printed or stored for later viewing (see col. 10 lns. 32-33). There is no suggestion that this newspaper is not intended for presentation by a display device.

Nehab does not disclose or suggest step (e) that generates a second representation of summary information having a form intended for presentation by a display device such that its presentation informs a recipient of the content included in the content information. The Office Action is silent with regard to this feature so Applicants cannot respond with any particularity.

Nehab does not disclose or suggest step (f) that delivers two representations pertaining to a newspaper, a first representation of content and a second representation that summarizes the content. Applicants note that the Office Action does refer to "both presentations" near the bottom of page 5 but it is not clear what "presentations" are being referred to. This reference is missing an antecedent.

#### *Claims 37-40*

The Office Action indicates claims 37-40 are rejected under 35 U.S.C. § 101 for being directed toward non-statutory subject matter. In response, Applicants amend claim 37 as shown above and request reconsideration.

The Office Action also indicates claims 37-40 are rejected under 35 U.S.C. § 103 as being unpatentable over Nehab in view Ferguson. Applicants respectfully disagree.

Referring to claim 37, the Office Action indicates Nehab discloses all that is claimed except receiving an indication of a measure of recipient interest.

Both references that are relied on disclose a system that defines a user profile (Nehab) or submits a user template (Ferguson) specifying criteria for articles in a newspaper. Neither reference discloses or suggests obtaining from the recipient a measure of interest in content that is identified in response to the profile or template.

The Office Action indicates this missing feature is disclosed in col. 4 lns. 6-60 of Ferguson. This is not correct. The text referred to describes only the submittal of a user template. For example, see col. 4 lns. 27-28 ("add these items to his custom newspaper template"), col. 4 lns. 32-33 ("automatically adds the selected entries to the custom newspaper template") and col. 4 lns. 42-52. This template is used to select the content of a newspaper and to control its format, much the same way as the user profile is used in Nehab and the "profile" recited in claim 37 is used in the claimed method. Having obtained that content, neither Nehab nor Ferguson disclose or suggest receiving anything from the user or recipient based on the content of a delivered newspaper to revise the user profile or template. The systems disclosed in Nehab and Ferguson both require a user to manually revise his profile or template as desired. In contrast to that, the claimed method automatically revises a profile in response to some measure of recipient interest in content such as, for example, by printing selected articles.

### CONCLUSION

Applicants amend the claims as shown above and request reconsideration in view of the previous remarks.

Respectfully submitted,



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### Certificate of Transmission

I certify that this Response to Office Action and any following materials are being transmitted by facsimile on April 6, 2005 to the U.S. Patent and Trademark Office at telephone number (703) 872-9306.



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